<u>REMARKS</u>

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 2, 4-15, and 20-31 are pending in this application; Claims 3 and 16-19 having previously been canceled without prejudice or disclaimer; and Claims 1, 4-12, 14, 20, 22, 24, 26-28, 30, and 31 having been amended by the present Amendment. Support for amended Claims 1, 4-12, 14, 20, 22, 24, 26-28, 30, and 31 can be found, for example, in the original claims, drawings, and specification as originally filed.[1] No new matter has been added.

In the outstanding Office Action, the claims were objected to due to informalities; Claims 1, 2, 4-15, and 20-31 were rejected under 35 U.S.C. §112, first paragraph; Claims 7-11, 14, 22, 26, and 31 were rejected under 35 U.S.C. §112, second paragraph; Claims 1, 2, 4-15, and 20-30 were rejected under 35 U.S.C. §103(a) as unpatentable over <u>Hatae et al.</u> (U.S. Patent Publication No. 2003/0193948; hereinafter "<u>Hatae</u>") further in view of <u>Fukuhara et al.</u> (U.S. Patent No. 7,127,111; hereinafter "<u>Fukuhara</u>"), <u>Long</u> (U.S. Patent No. 5,768,424), and <u>Delean</u> (U.S. Patent No. 5,907,640); and Claim 31 was rejected under 35 U.S.C. §103(a) as unpatentable over <u>Hatae</u>, <u>Fukuhara</u>, <u>Long</u>, <u>Delean</u> in view of <u>Engeldrum et al.</u> (U.S. Patent Publication No. 2002/0003903; hereinafter "<u>Engeldrum</u>").

In response to the objection to the claims, Applicant has amended the claims in accordance with the suggestions set forth in the outstanding Office Action. Accordingly, Applicant respectfully submits that the objections to the claims have been overcome.

In response to the rejection of Claims 1, 2, 4-15, and 20-31 under 35 U.S.C. § 112, first paragraph, Applicant respectfully submits that these claims comply with the written description requirement. Page 6 of the outstanding Office Action states that "claim 1 recites

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[1] See original Claim 5; and page 12, line 1 to page 13, line 9 of the specification.

'apply the editing operation to the reversible code' in line 13. However, per lines 11-12 of amended Claim 1 as well as Fig. 5 and P. 28, line 14-P. 30, line 16 (especially lines 11-20 of page 29 and lines 4-16 on page 30) of the specification of instance (sic) application, editing and modification are applied to the decoded images, not the code itself.... Note: for examination purpose 'the reversible code' will be interpreted as 'the image obtained from decoding the reversible code'...."

Applicants respectfully submit that the feature "apply the editing operation to the reversible code" recited in Claim 1 is adequately described in the specification. For example, step S7 in Figure 5 and step S19 in Figure 8 each state "apply edit/modify contents to reversible code." Further, page 31, line 21 to page 32, line 1 of the specification clearly states:

> ...the non-reversible code is obtained as a part of the reversible code 42. As described above, according to the information 53 indicating the contents of the editing/modifying operation, *the reversible code* 41 is processed in step S7 *so that the contents of editing/modifying operation are reflected thereon*.
> (Emphasis Added).

In addition, page 33, lines 22-25 of the specification states that "a desired editing/modifying operation will be performed *on the reversible code 42* received from the server computer 6." Lastly, page 33, lines 6-11; and page 34, line 22 to page 35, line 3 of the specification also describe that that the edits can be applied to the reversible code.

Page 2 of the June 17, 2008 Advisory Action states:

> ...the new limitations of Claims 1, 7, 12, 20 are different from the cancelled limitation of claim 5 in that in claim 5 the determination is on whether the contents are reflected o[n] the image data in the form of reversible code or the original image. However, in amended claims 1, 7, 12, 20 the determination is on whether contents were performed by the cl[i]ent or the external apparatus....Additionally,...the determination is on whether the contents are "to be" (not "were" as in the amended claims) performed in the "Own" (i.e., client) or the external apparatus. Therefore the new limitations have no support in the instant specification.

14

Applicant respectfully submits that the feature of a "a determining unit configured to determine whether contents of an operation of editing or modifying image data which are applied to the image data in a form of reversible code or the original image were performed by the client apparatus or by another external apparatus," as recited in, for example, Claim 1, does not contain new matter. The above feature is supported, for example, at page 33, line 22 to page 35, line 3 of the specification. Page 34, lines 3- 8 of the specification specifically states that "it is determined whether the actual operation of actually reflecting the contents of the editing/modifying operation (performed by a user of the client computer 6) onto the reversible code 42 is executed in the own apparatus (client computer 7) or in the printer 9 instead." Thus, Applicant respectfully submits that the claimed "determining unit" is adequately supported in the specification.

Accordingly, Applicant respectfully requests the rejection of Claims 1, 2, 4-15, and 20-31 under 35 U.S.C. § 112, first paragraph, be withdrawn.

In response to the rejection of Claims 7, 11, 14, 22, 26, and 31 under 35 U.S.C. §112, second paragraph, Applicant has amended the claims to correct the informalities set forth in the outstanding Office Action.

Accordingly, Applicant respectfully requests that the rejection of Claims 7, 11, 14, 22, 26, and 31 under 35 U.S.C. §112, second paragraph, be withdrawn.

In response to the rejection of Claims 1, 2, 4-15, and 20-30 under 35 U.S.C. §103(a) as unpatentable over Hatae in view of Fukuhara, Long, and Delean; and the rejection of Claim 31 under 35 U.S.C. §103(a), Applicant respectfully submits that amended independent Claim 1 recites novel features clearly not taught or rendered obvious by the applied references.

Amended independent Claim 1 is directed to an image processing system including, *inter alia*:

15

> ...a determining unit configured to determine whether
> contents of an operation of editing or modifying image data
> which are applied to the image data in a form of reversible code
> or the original image were performed by the client apparatus or
> by another external apparatus ....

Page 11 of the outstanding Office Action, in the rejection of Claim 5, states that

Delean describes a "determining part configured to determine whether the contents of

operation of editing or modifying for the image data are actually reflected on the image data

in the form of reversible code or the original image by the own apparatus or by another

external apparatus."

Delean describes that an "expression tree contains parameters that define the editing

effects to ultimately be applied to the image. The content of the FITS file or the expression

tree before it is saved to a FITS file is used by the raster image processing routine to generate

an output."[2] However, Delean fails to teach or suggest "a determining unit configured to

determine whether contents of an operation of editing or modifying image data which are

applied to the image data in a form of reversible code or the original image were performed

by the client apparatus or by another external apparatus," as recited in Applicant's amended

independent Claim 1.

Delean merely describes that the FITS file can be displayed, printed, or exported to a

desktop publishing system. Delean does not describe that it determined whether contents of

an operation of editing or modifying the FITS file which are applied to the FITS file in a form

of reversible code or the original image by were carried out by a client apparatus or by

another external apparatus. In other words, in Delean, there is no indication of the type of

apparatus that modified the image data.

Accordingly, Applicant respectfully submits that amended independent Claim 1 (and

all claims depending thereon) patentably distinguishes over Delean.

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[2] See Delean at column 3, lines 31-38.

Further, Applicant respectfully submits that <u>Hatae</u>, <u>Fukuhara</u>, and <u>Long</u> fail to cure any of the above-noted deficiencies of <u>Delean</u>.

Amended independent Claim 7 recites "a determining unit configured to determine whether contents of an operation of editing or modifying image data which are applied to the image data in a form of reversible code or the original image were performed by the image forming apparatus or by another external apparatus." Thus, independent Claim 7 (and all claims depending thereon) are believed to be patentable for at least the reasons discussed above.

Amended independent Claims 12 and 20 recite "determining whether contents of an operation of editing or modifying image data which are applied to the image data in a form of reversible code or the original image were performed by a client apparatus executing said method or by another external apparatus." Thus, independent Claims 12 and 20 (and all claims depending thereon) are believed to be patentable for at least the reasons discussed above.

Amended independent Claim 24 recites "determining whether contents of an operation of editing or modifying image data which are applied to the image data in a form of reversible code or the original image were performed by the client apparatus or by another external apparatus." Thus, independent Claim 24 (and all claims depending thereon) is believed to be patentable for at least the reasons discussed above.
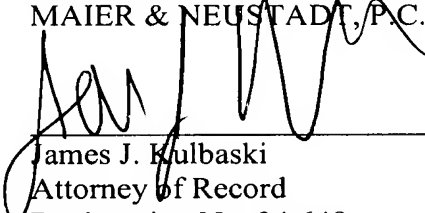
In regard to the rejection of Claim 31, Applicant notes that Claim 31 is dependent on Claim 1 and is believed to be patentable for at least the reasons discussed above. Further, Applicant respectfully submits that <u>Engeldrum</u> fails to cure any of the above-noted deficiencies of <u>Hatae</u>, <u>Fukuhara</u>, <u>Long</u>, and <u>Delean</u>.

Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. §103(a) be withdrawn.

Consequently, in view of the present amendment, and in light of the above discussion,

the pending claims as presented herewith are believed to be in condition for formal

allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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